

### **Remarks**

Claims 41-69 stand rejected. Claims 41 and 54 have been amended to improve clarity, making it more clear that the marks made by the player also indicate the quantity of quick picks that the player selects. The amendment is supported by the originally filed disclosure and does not add new matter.

Applicant respectfully submits that all of the presently pending claims are allowable. Reconsideration of the Application is respectfully requested in light of the Amendment and the following comments.

#### **Rejection of claims 41-46, 49-58, 62, 63, 69 over Jarvis in view of Novak**

Claims 41-46, 49-58, 62, 63, and 69 stand rejected under 35 U.S.C. 103 over Jarvis in view of Novak. Claim 41 recites:

41. (Currently amended) A method of processing a gaming slip, comprising:  
reading a random request region corresponding to a single game from the gaming slip, the random request region having a player's written mark made with a writing instrument, ***the written mark indicating the player's request for a plurality of randomly generated picks in the single game;*** and  
responsive to reading the random request region, generating the requested plurality of randomly generated picks for the single game, each pick including a plurality of randomly-generated numbers, ***the quantity of picks generated for the single game being determined based on information*** read from the random request region and indicated by the player's written mark.

The Office Action admits that Jarvis fails to disclose "a plurality of quick picks may be selected for a single game".

To correct the defects of Jarvis as a reference, the Office Action proposes a combination with Novak. However the proffered reason for the modification proffered in the Office Action is to allow a user to "increase the chances of winning". This makes no sense, as the player could simply by more tickets, or non quick-pick tickets to achieve the same result.

Moreover, as pointed out in a prior paper, Novak teaches expressly away from the

proposed combination. It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 744, (Fed. Cir. 1983) (The claimed catalyst which contained both iron and an alkali metal was not suggested by the combination of a reference which taught the interchangeability of antimony and alkali metal with the same beneficial result, combined with a reference expressly excluding antimony from, and adding iron to, a catalyst.). The Office Action responds that:

*Whether Novak teaches away from the use of manual playslips is immaterial, as Novak is not cited as the primary reference and no proposed modifications are being made to the device and method of Novak.*

Office Action at 5-6. The Office Action has not given, and Applicant has not noted any support for this proposition in either the MPEP or case law. The important fact that Novak teaches away from the combination remains unrebutted and unconsidered in the present Office Action.

The fact remains that Novak expressly teaches away from manual playslips, and this would lead an ordinary artisan to use Novak's device, rather than try to import features to what Novak classifies as an inferior approach. Thus an ordinary artisan would not have been lead by Novak to modify Jarvis. The fact that Applicant's invention proceeds in a direction contrary to Novak's accepted wisdom that paper play slips should be abandoned or are obsolete, is evidence of non-obviousness. See MPEP 2145.X. "Known disadvantages in old devices which would naturally discourage search for new inventions may be taken into account in determining obviousness." *United States v. Adams*, 383 U.S. 39, 52, 148 U.S.P.Q. 479, 484 (1966).

Separately and independently, Applicant respectfully submits that the Jarvis also fails to disclose the feature added by the present amendment, "the quantity of picks generated for the single game being determined based on information read from the random request region and indicated by the player's written mark". The Office Action's proposed addition of Novak to Jarvis, also fails to provide this feature, as it is found in neither Novak nor Jarvis.

Claims 42-45 and 48-50 depend from claim 41 and therefore should be allowable for at least similar reasons as given above for claim 41. Claims 51-53 recites similar features in

Beauregard article of manufacture form, and therefore should be allowable for similar reasons to the method claims discussed above.

Claim 54 recites:

54. A gaming slip, comprising:  
a substrate; and  
gaming information coupled to the substrate, the gaming information including a random request region having a marking area corresponding to a single game,  
wherein the *random request region corresponding to the single game is configured to enable a player to request a plurality of computer generated picks for the single game* by writing in the marking area with a writing instrument,  
and wherein the random request region corresponding to the single game is configured so that *the quantity of computer-generated picks for the single game is indicated by the writing made in the marking area* by the player with the writing instrument.

While no specific rejection of claim 54 is given in the current Office Action, it is believed that claim 54 should be allowable for at least reasons similar to those given above for claim 41. Claims 55-58, 62, 63, and 69 depend from claim 54 and therefore should be allowable for at least similar reasons.

**Rejection of claims 47, 66, and 67 over Jarvis in view of Novak and Alexoff**

Claims 47, 66, and 57 stand rejected under 35 U.S.C. 103 over Jarvis in view of Novak and Alexoff. Claim 47 depends from claim 41, and claims, 66, and 67 depend from 54. Therefore these claims should be allowable for at least the reasons given above for their respective parent claims.

**Rejection of claims 59-61, and 64 over Jarvis in view of Novak and Alvarez**

Claims 59-61 and 64 stand rejected under 35 U.S.C. 103 over Jarvis in view of Novak and Alvarez. Claims 59-61 and 64 depend from claim 54. Therefore these claims should be allowable for at least the reasons given above for their parent claim.

All issues raised in the Office Action are believed to have been addressed. Prompt reconsideration and passage to allowance is respectfully requested. The Office is authorized to charge any fees associated with this paper to Kenyon & Kenyon LLP, Deposit Account No. 11-0600.

Respectfully submitted,

KENYON & KENYON LLP

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